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In re Application of WOOLFE et al.
Application No.: 10/516,943
PCT No.: PCT/GB03/02669
Int. Filing: 20 June 2003
Priority Date: 22 June 2002
Attorney Docket No.: 00303/US
For: PHARMACEUTICAL COMPOSITION

:
: DECISION ON
:
: RENEWED PETITION
:
: UNDER 37 CFR 1.47(a)
:

This is a decision on applicant's second renewed petition under 37 CFR 1.47(a), filed in the United States Patent and Trademark Office (USPTO) on 04 December 2006, to accept the application without the signatures of joint inventors, Jacqueline Yvonne Allen and Mark Clifford Elliott.

BACKGROUND

On 16 December 2004, applicant filed a transmittal letter (PTO-1390) requesting entry into the national stage in the United States of America under 35 U.S.C. § 371. Filed with the Transmittal Letter was, *inter alia*, the requisite basic national fee.

On 17 May 2005, a Notification of Missing Requirements (FORM PCT/DO/EO/905) was mailed to applicant indicating *inter alia*, that an oath or declaration in accordance with 37 CFR 1.497(a) and (b) and the surcharge for filing the oath or declaration after the thirty month period was required.

On 17 November 2005, applicant filed a petition under 37 CFR 1.47(a), along with a declaration, executed by the joint inventors on behalf of the nonsigning inventors. The petition under 37 CFR 1.47(a), in an attempt to satisfy the requirements of 35 U.S.C. 371(c)(4), requested the acceptance of the application without the signatures of inventors Jacqueline Yvonne Allen and Mark Clifford Elliott, alleging that Ms. Allen refuses to sign the application and Mr. Elliott is unavailable.

On 24 February 2006, a decision dismissing the petition under 37 CFR 1.47(a) was mailed to applicant indicating that Petitioner had not provided evidence that a complete copy of the application papers, including specification, claims and drawings and declaration, were provided to Ms. Allen and that diligent efforts to locate Mr. Elliott were not pursued and documented.

On 26 June 2006, applicant filed a renewed petition under 37 CFR 1.47(a) with a request for a two month extension of time. On 02 October 2006, a decision dismissing the petition was mailed indicating that Petitioner had provided sufficient evidence of Ms. Allen's refusal to sign

but had not furnished sufficient evidence to conclude that Mr. Elliott refused to sign the application papers or was unavailable.

On 4 December 2006, Petitioner filed a second renewed petition under 37 CFR 1.47(a).

DISCUSSION

As previously stated, a petition under 37 CFR §1.47(a) must be accompanied by (1) the fee under 37 CFR §1.17(g), (2) factual proof that the non-signing joint inventor(s) refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the non-signing inventor(s), and (4) an oath or declaration by each available joint inventor on his or her own behalf and on behalf of the non-signing joint inventor(s).

Item (1), (3) and (4) were previously satisfied.

Unavailability of Inventor Elliott¹

With respect to counsel's inability to find or reach Mr. Elliott, Petitioner now presents the affidavit of Samantha Claire Radley. Ms. Radley's affidavit states that she conducted an Internet search for "Mr. Elliot" without success. However, it is noted that the nonsigning inventor's name is identified as Mark Clifford *Elliott*, on the published international application for PCT/GB03/02669, with Mr. Elliott's last name containing two *ts*. Since Mr. Elliott's name was misspelled for the Internet search, a new Internet search must be conducted for Mark Clifford Elliott, as the inventor's name is correctly spelled.

Sufficient diligent efforts made to locate Mr. *Elliott* must be pursued and documented, such as Internet searches, E-mail contact to obtain a current address, contact with his former employer(s) or joint inventor(s) to obtain a forwarding address or a request from the Postal Service for his forwarding address. As stated previously, where inability to find or reach a nonsigning inventor "after diligent effort"² is the reason for filing under 37 CFR 1.47, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a "diligent effort" was made. Petitioner's statement of facts under 37 CFR 1.47(a) should indicate that a further search for Mr. *Elliott*'s new address was made. Since attempts to locate inventor *Elliott* were insufficient, it can not be concluded at this time that "a diligent

¹ As indicated in the MPEP Section 409.03(d), where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made. The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should be included in the statement of facts. It is important that the statement contain facts as opposed to conclusions.

effort" was made to locate the non-signing inventor and that Mr. Elliott is unavailable to sign the application.

In sum, Petitioner has satisfied Items (1), (3) and (4) above. With regard to Item (2), Petitioner has not satisfied Item (2) with respect to Mr. Elliott, that is, that "diligent efforts" were made to contact the nonsigning inventor Mark Clifford *Elliott* using Internet searches and the correct spelling of his name.

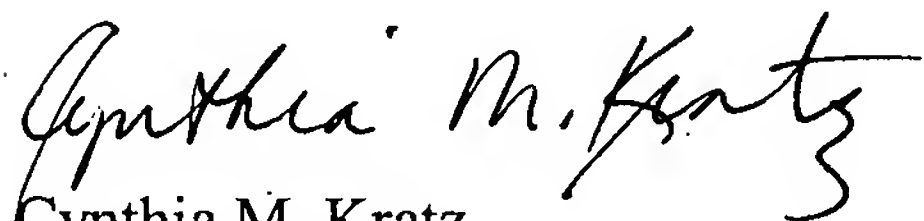
Petitioner should pursue further efforts in a diligent attempt to locate Mr. Elliott before it can be concluded that Mr. Elliott is unavailable. Accordingly, it is inappropriate to accord the national stage application status under 37 CFR §1.47(a) at this time.

CONCLUSION

The petition under 37 CFR §1.47(a) is **DISMISSED WITHOUT PREJUDICE**.

Any reconsideration on the merits of the petition under 37 CFR §1.47(a) must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR §1.47(a)." No petition fee is required. Any further extensions of time available may be obtained under 37 CFR 1.136(a).

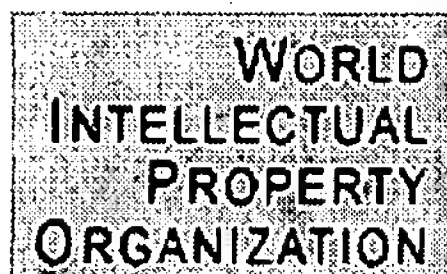
Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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Enclosure: First page of WO/2004/000290 (the publication of PCT/GB03/02669)



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(WO/2004/000290) PHARMACEUTICAL COMPOSITION

Biblio. Data

Description

Claims

National Phase

Notices

Documents

Latest bibliographic data on file with the International Bureau

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Priority Data: 0214491.3 22.06.2002 GB

0228111.1 03.12.2002 GB

Title: PHARMACEUTICAL COMPOSITION

Abstract: A pharmaceutical composition for administration as an aerosol, which comprises a cannabinoid, a propellant and an effective amount of a cough suppressant.

Designated States: AE, AG, AL, AM, AT, AU, AZ, BA, BB, BG, BR, BY, BZ, CA, CH, CN, CO, CR, CU, CZ, DE, DK, DM, DZ, EC, EE, ES, FI, GB, GD, GE, GH, GM, HR, HU, ID, IL, IN, IS, JP, KE, KG, KP, KR, KZ, LC, LK, LR, LS, LT, LU, LV, MA, MD, MG, MK, MN, MW, MX, MZ, NO, NZ, OM, PH, PL, PT, RO, RU, SC, SD, SE, SG, SK, SL, TJ, TM, TN, TR, TT, TZ, UA, UG, US, UZ, VC, VN, YU, ZA, ZM, ZW.

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Eurasian Patent Organization (EAPO) (AM, AZ, BY, KG, KZ, MD, RU, TJ, TM)

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